

REMARKS

Applicants respectfully request reconsideration of the instant application in the view of the preceding amendments and/or the following remarks. By way of the instant Response, new claim 68 has been added and claims 1, 29, 33, 35, 39-51, 61-63 and 67 have been amended to provide clarification, better track current business practices, and/or to correct minor typographical informalities. Applicants submit that support for the new claim and amendments may be found throughout the originally filed specification, drawings and claims, and that no new matter has been added by way of this Response. Applicants explicitly reserve the right to add/pursue the claims as originally filed at a later date and/or in one or more continuation applications. Furthermore, Applicants submit that the claims as originally filed are patentably distinct from the cited references. Claims 1-68 are currently pending.

Rejections under 35 U.S.C. § 103

Claims 1-67 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Katz, et al. (US Patent No. 6,055,513) ("Katz"); Tasker ("Should We Send Bad Guys' Guns to the Contras?") ("Tasker"); Johnson ("Family Dollar on the Move") ("Johnson"); Dinell ("Businesses Taking a Hard Look at Air Travel as Fares Increase" ("Dinell")); an anonymous article ("Western Pacific Load Factor Reaches 55 Percent in September") ("Western Pacific"); De Lapa et al. (US Patent No. 5,822,735) ("De Lapa"); O'Brien, et al. (US Patent No. 5,832,457) ("O'Brien"); Popyk ("The Mastercard Approach to Customer Service") ("Popyk"); Webber, et al. (US Patent No. 5,331,546) ("Webber"); Brown, et al. (US Patent Application No. 2006/0206393) ("Brown"); Caldwell ("Hotels Pull a Switch") ("Caldwell"); and the Examiner's Official Notice. Although Applicants respectfully traverse the Examiner's

rejections and submit that the Examiner has not established a *prima facie* case of obviousness and that the pending claims are patentably distinct from the eleven cited references and Examiner's Official Notice, taken alone or in combination, Applicants have amended the independent claims to provide clarification and better track current business practices.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Amended independent claim 1 recites, *inter alia*

A computer-implemented method for offering a travel product for sale, comprising:

...
computing values to a seller associated with the preferred travel product record and the at least one alternate travel product record based on at least one travel product relation parameter;

selecting at least one alternate travel product based on the at least one received alternate travel product record, wherein the at least one alternate travel product provides a greater value to a seller if sold than the preferred travel product and is related to the preferred travel product by the at least one travel product relation parameter that is configured as an electronic data structure; ...
...

Applicants submit that the references, taken alone or in combination, do not discuss or render obvious at least these elements from independent claim 1. The pending rejection has alleged that independent claim 1 is rendered obvious by Katz in view of Tasker.

Applicants respectfully traverse this allegation and submit that neither Katz, Tasker, nor any of the other cited references, taken alone or in combination, discuss or render obvious "computing values to a seller associated with the preferred travel product record and the at least one alternate travel product record based on at least one travel product relation parameter," as recited in independent claim 1. The pending rejection has further alleged that "Tasker further teaches that an alternate travel product being upsold is related to the preferred travel product by at least one travel product relation parameter (in that both are hotel rooms, and presumably covering the same time period; 'SUITENING THE POT' section)." (August 1, 2008 Office Action, p. 4, ¶ 1). Applicants respectfully traverse this allegation and submit that the "techniques of 'upselling'" comprising "talk[ing] him [the guest] into a more expensive room" does not anticipate or render obvious "at least one travel product relation parameter configured as an electronic data structure," as recited in independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to how the Examiner believes the cited references allegedly discuss "computing values to a seller associated with the preferred travel product record and the at least one alternate travel product record based on at least one travel product relation parameter," and, "at least one travel product relation parameter that is configured as an electronic data structure," as recited in independent claim 1.

Applicants further note that the pending rejection has grouped multiple claim elements together for rejection under a single group of reference citations. For example, the pending rejection recites

As per claim 29, Katz discloses a computer-implemented method for offering a product for sale, comprising: receiving an

inquiry indicative of a preferred product from a customer, and receiving at least one alternate product record from a database, wherein the at least one alternate product record is based upon the product inquiry, the alternate product record being indicative of an alternate product; selecting at least one alternate product, based on the at least one alternate product record; transmitting an offer to sell the selected product to a customer; and receiving an acceptance to purchase the at least one alternate product from the customer (Abstract; Figure 4; Figure 7; column 8, line 34, through column 9, line 21; column 11, line 62, through column 12, line 39; column 19, lines 24-58; column 23, line 40, through column 24, line 11; column 25, line 56, through column 26, line 3; column 26, lines 13-37). (August 1, 2008 Office Action, p. 15, ¶1)

Applicants are unclear as to how exactly the Examiner is alleging correspondence between particular claim elements and sections of the cited references. The MPEP prescribes that, "[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied upon must be designated as nearly as practicable," and that, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." (MPEP § 706). Applicants submit that an omnibus rejection of multiple claim elements that does not provide specific correspondence between claim elements and reference citations does not designate "the particular part relied upon ... as nearly as practicable" and does not "clearly articulate" the rejection. Accordingly, should the Examiner maintain the rejection, Applicants respectfully request that he indicate specific alleged correspondences between claim elements and reference citations in order to facilitate Applicants' full understanding of the Examiner's concerns.

Furthermore, Applicants submit that the pending rejection has failed to properly set forth the differences in the claims over the applied references and to explain why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention

was made by proposing modifications to art that teaches away from such modifications and that would render the cited art unsuitable for its stated purpose, by failing to provide sufficient objective rationale for modifying the references, and by not providing a discussion of the level of ordinary skill in the art.

MPEP 2143.01 (V) prescribes, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose," and, "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." In the pending rejection, the Examiner acknowledges that "Katz does not expressly disclose ... that the alternate travel product is related to the preferred travel product by at least one travel product relation parameter," and that, "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention ... for the alternate travel product to be related to the preferred travel product by at least one travel product relation parameter." (August 1, 2008 Office Action, p. 4, ¶ 1). Applicants respectfully traverse this argument and suggest that Katz teaches away from the proposed modification, including a combination with Tasker, and that a combination with Tasker renders Katz unsuitable for its stated purpose. By way of example only, Applicants draw the Examiner's attention to col. 1, lines 13-16 of Katz, which recites, "Most particularly, they [the methods and apparatuses described in Katz] relate to the selection and offering of an upsell transaction, namely where the product or service offered differs materially from the product or service for which the contact was made." (emphasis added). Applicants submit that at least this part of Katz comprises a clear teaching away from the proposed modification as well as an intended purpose of Katz for which the proposed modification of the pending rejection would render

Katz unsuitable. Applicants therefore submit that the pending rejection has applied impermissible hindsight and that a *prima facie* showing of obviousness has not been made. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

Applicants further submit that the pending rejection has not even alleged that the claims as wholes would have been obvious to one of ordinary skill in the art at the time of Applicants' invention. MPEP § 2141.02 (I) prescribes, "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious."¹¹ (original emphasis). Applicants raised this issue in the June 20, 2008 Response (see p. 30 ¶ 1 to p. 31 ¶ 1) in reference to the Examiner's rejection. In response, the pending rejection alleges, "Applicants' objection to Examiner's alleged 'dissection' of the claims seems to be a form of 'piecemeal analysis' of the references: In response to applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of the references." (August 1, 2008 Office Action, p. 30, ¶ 2). Applicants respectfully traverse this characterization and submit that the Examiner has misunderstood Applicants' prior objection. The MPEP requires that the Examiner address the obviousness of proposed modifications to the references in respect to the claim as a whole, and not in respect to specific proposed modifications. By way of example only, Applicants note that the pending rejection has alleged, "Katz does not expressly disclose that the at least one alternate product provides a greater value to a seller if sold than the preferred product, *but this motivation is considered obvious.*" (August 1, 2008 Office Action, p. 4, ¶ 1; emphasis added). In another example, the pending rejection alleges, "it would have been

obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the products to be travel products." (August 1, 2008 Office Action, p. 4, ¶ 1). In still another example, the pending rejection alleges, "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate a benefit rating based on a difference between the preferred and alternate products." (August 1, 2008 Office Action, p. 7 ¶ 1). Applicants submit that the pending rejection has only addressed the alleged obviousness of "the differences themselves" and has never addressed "whether the claimed invention as a whole would have been obvious," as required, *inter alia*, by MPEP § 2141.02 (I). Applicants therefore submit that the pending rejection has failed to provide sufficient objective rationale for the proposed modification of the references and that a *prima facie* showing of obviousness has not been made. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of the rejection. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to how the Examiner believes "the claimed invention as a whole would have been obvious" to one of ordinary skill in the art.

Applicants also submit that the pending rejection has provided no indication of the level of ordinary skill in the art. MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The pending rejection refers to, "one of ordinary skill in the art of electronic commerce," (e.g., August 1, 2008 Office Action, p. 4, ¶ 1) but has provided no indication or discussion of the level of ordinary skill associated therewith. The rejection's reference to "the art of electronic commerce" is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art

lies in the necessity of maintaining objectivity in the obviousness inquiry." Applicants submit that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicants respectfully request that, if the Examiner maintains this rejection, the Examiner discuss the level of ordinary skill in the art at the time of the invention and clarify how the claimed subject matter would have been obvious to one possessing that level of skill.

Applicants further submit that none of the other cited references remedy the deficiencies identified above with respect to Katz and Tasker in relation to independent claim 1. Furthermore, although of different scope than independent claim 1, Applicants submit that independent claims 29, 33, 35, 39-51, 61-63, 67 and 68 are also are patentable over the cited references, taken alone or in combination, for at least similar reasons to those discussed above identifying deficiencies in the cited references in relation to independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection for these claims as well.

Applicants also submit that claims 2-28, 30-32, 34, 36-38, 52-60 and 64-66, which are directly or indirectly dependent from independent claims 1, 29, 33, 35, 39-51, and 61-63, are also not discussed or rendered obvious by the cited references, taken alone or in combination, for at least similar reasons to those discussed above identifying deficiencies in the cited references in relation to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection for these claims as well.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-68, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicants assert that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserve the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17200-079US1. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17200-079US1.

Respectfully submitted,
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